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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/086,406

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Terry H. Beck

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EXAMINER

DASS, HARISH T

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/086,406

Applicant(s)

BECK ET AL.

Examiner

HARISH T. DASS

Art Unit

3692

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-156 is/are pending in the application.
- 4a) Of the above claim(s) 2-11, 27-80, 82-91 and 106-152 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 12-26, 81, 92-105 and 153-156 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/4/02
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Acknowledgement: Examiner acknowledges submission of Applicant's election of species (7/25/2008) correspond to claims 1, 12-26 and 81, 92-105 elected provisionally for prosecution.

Note: Page 2 of remarks has an error, line 9 should read "non-elected Claims 2-11, 27-80, 82-91, and 106-152 ..."

2. ***Status of claims:***

Claims 1, 12-26, 81, 92-105 and 153-156 are pending.

Claims 2-11, 27-80, 82-91, and 106-152 are withdrawn.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 12-26, 81, and 92-105 are rejected under 35 U.S.C. § 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). The process steps in claims (1, 12-26, 81, and

92-105) are not tied to another statutory class nor do they execute a transformation. Thus, they are non-statutory.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 155-156 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, system claims 155-156 recites in the preamble "A system for processing electronically presented items", the body of the claim does not contain any limitations indicating the structure of the device. A system or an apparatus claim should always claim the structure or the hardware that performs the function. It is not clear the claimed system is a hardware or software. Applicant's specification includes reference to hardware as-will-as modules (software according to the specification) and that does not describe the structure of the device. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 12-26, 81, 92-105 and 153-156 rejected under 35 U.S.C. 103(a) as being unpatentable over Vicknair et al. (hereinafter Vicknair - US 2003/0208421 A1) in view of Bellinger et al. (hereinafter Bellinger - US 5,870,725).

Re. Claim 1, Vicknair discloses receiving at a first time a plurality of electronically presented items, wherein one or more of the items received is comprised of a source key and transaction data associated with the source key (key or ISN) [see entire document which is relevant to particularly, Abstract; Figures 1-2; paragraphs 8, 15-20 (ECP); claim 6 (key)];

for each item received at the first time, assigning an electronic item presentment (EIP) sequence number to the item, associating the item's transaction data with the item's EIP sequence number, and associating the item's EIP sequence number with the item's source key [paragraphs 37-38 (ISN)];

receiving at a second time image data for one or more of the items received the first time, wherein the image data for each item received at the second time is associated with the item's source key [paragraphs 31, 34]; and

for each item received at the second time, associating the item's image sequence number with the item's EIP sequence number by matching (i) the source key associated with the item's EIP sequence number received at the first time with (ii) the source key associated with the item's image sequence number received at the second time [paragraphs 11; claim 1].

Vicknair *does not explicitly disclose* for each item received at the second time, assigning an image sequence number to the item, associating the item's image data with the item's image

sequence number and associating the item's image sequence number with the item's source key.

However, Rational database such as: IBM DBII, Oracle 8i, MySQL, Sybase, etc are well-known and used for assigning a primary key, secondary key, indexing, correlating the records, etc.

Bellinger discloses for each item received at the second time, assigning an image sequence number to the item (image identification key), associating the item's image data with the item's image sequence number and associating the item's image sequence number with the item's source key (MICR data) [Figures 5, 20-22; col. 6 lines 15-25, col. 12 lines 14-20; col. 15 lines 1-4].

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Vicknair and include for each item received at the second time, assigning an image sequence number to the item (image identification key), associating the item's image data with the item's image sequence number and associating the item's image sequence number with the item's source key as disclosed by Bellinger and use of known image capturing tools and known database tools for keeping and manipulating records, to complement the microfilm check images and provide a digitally captured images of checks stored on readable medium for indexing and cross referencing which allows the customer to retrieve the items using personal computer.

Re. Claim 2, Vicknair discloses wherein the source key is comprised of a source sequence number, a source identifier and a source processing date [paragraph 8].

Re. Claim 3, Vicknair discloses wherein the source key is *stored* in an archive in association with the EIP sequence number [paragraphs 10, 14].

Re. Claim 4, Vicknair discloses wherein the image sequence number is *stored* in the archive in association with the EIP sequence number [paragraph 13].

Re. Claims 5-11, Bellinger further discloses wherein an image key is *stored* in the archive in association with the EIP sequence number and the image key is comprised of the image sequence number, a capture date and a capture cycle; wherein the image data is *stored* in an archive in association with the EIP sequence number; wherein the image data is *stored* in an archive in association with the source key; wherein the image data is *stored* in an archive in association with the image sequence number; wherein the image data is *stored* in an archive in association with an image key; and wherein the image key is comprised of the image sequence number, a capture date and a capture cycle [Figures 20-22; col. 12 lines 10-20]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Vicknair and include the above feature as disclosed by Bellinger to index the check information using image key and allow the user to retrieve the check information from database using image identification as a retrieval key..

Re. Claim 12, Vicknair discloses for each of the items to which an EIP sequence number has been assigned, posting the item's transaction data to a posting system and associating the item's posted transaction data with the item's EIP sequence number [paragraphs 06-07].

Re. Claims 13-26, Bellinger further discloses for each of the items to which an EIP sequence number has been assigned, posting at least some of the item's transaction data to a posting system and associating the item's posted transaction data with the item's EIP sequence number [Figures 20-22 and associated descriptions; col. 2 lines 52-61; col. 13 line 55 through col. 14 line 26]; wherein the item's posted transaction data is *stored* in an archive in association with the item's EIP sequence number; wherein the item's posted transaction data is *stored* in an archive in association with the item's source key; wherein the item's posted transaction data is *stored* in an archive in association with the item's image sequence number; wherein the item's posted transaction data is *stored* in an archive in association with an image key; wherein the image key is comprised of the image sequence number, a capture date and a capture cycle; wherein the posting system is pre-existing (business choice); assigning a posting sequence number to each item posted; and associating the item's posting sequence number with the item's posted transaction data; wherein the item's posted transaction data is *stored* in an archive in association with the item's posting sequence number; wherein the item's posted transaction data is *stored* in an archive in association with the item's EIP sequence number; wherein the item's posted transaction data is *stored* in an archive in association with the item's source key; wherein the item's posted transaction data is *stored* in an archive in association with the item's image

sequence number; wherein the item's posted transaction data is *stored* in an archive in association with an image key; and wherein the image key is comprised of the image sequence number, a capture date and a capture cycle [Figures 20-22; col. 12 lines 10-20; col. 3 lines 25-31; col. 4 lines 13-35]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Vicknair and include the above feature, as disclosed Bellinger by posing and storing of the items with image identification number crossed reference with EIP sequence number, account number, etc to make it possible for indexing the item with different keys/fields which may serve as an effective way to retrieve the item if only a limited information is known about the item.

Re. Claims 81, 153-156 are rejected with same rational as claim 1 (Vicknair in view of Bellinger).

Re. Claims 92-105, are rejected with same rational as claims 13-26.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HARISH T. DASS whose telephone number is (571)272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Abdi Kambiz can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harish T Dass/
Examiner, Art Unit 3692

9/8/08